

Patent
999/017 USA**Response to Claim Rejections – 35 U.S.C. § 103**

To establish a prima facie case of obviousness, there must be some suggestion or motivation for the combination of references. Reference is made to MPEP §2142:

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 § 2144.09 for examples of reasoning supporting obviousness rejections."

The rejections of claims 1-3 are based on the combination of Dobak (USPN 6,254,626) and Dato (USPN 3,425,419). A full review of these references illustrates, however, that there is no teaching, suggestion or motivation for their combination as required by the foregoing standard presented in MPEP §2142. In the Office Action (page 5), it admits that "Dobak states that total body hypothermia has undesirable side effects and is difficult to administer..." In Dobak, reference is made to the Dato reference in which Dobak states "[h]owever, use of the Dato device implicates the *negative effects* of total body hypothermia described above. Due to the problems associated with total body hypothermia, attempts have been made to provide more selective cooling" (emphasis added). Dobak, col. 2, ll. 7-11. Clearly, Dobak teaches away from combining its teachings with that disclosed in Dato. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP 2143.01. In this particular instance, not only does Dobak not suggest the combination with Dato, Dobak warns against such combination by stating that it could implicate negative effects.

Additionally, a "statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references." *Ex parte Levensgood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993); MPEP 2143.01. Thus, the mere statement from the Office Action (page 5) that "it is clear from

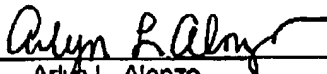
Patent
999/017 USA

Dobak disclosure that the method of inducing hypothermia by advancing a heat exchange catheter into a central venous vein is well known in the art" is by itself not sufficient to establish a prima facie case of obviousness. Hence combining the two references of Dobak and Dato would not be proper. As set forth in the MPEP, a prima facie case of obviousness therefore cannot be founded in Dobak or Dato.

CONCLUSION

In view of the foregoing presentation relying heavily on the standards established in the MPEP, the application is believed to be properly formed and the claims patentable. Consequently, a notice of allowance is earnestly solicited. If the Examiner believes that a telephone call would help advance prosecution of the present invention, the Examiner is kindly invited to call the undersigned attorney, Arlyn Alonzo, at (949) 453-0150 Ext. 146

Respectfully submitted,

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